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Tomohiro Koyata

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EXAMINER

LE, NANCY LOAN T

ART UNIT

PAPER NUMBER

3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/085,462

**Applicant(s)**

KOYATA ET AL.

**Examiner**

NANCY T. LE

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 6-8, 10, 11, 13, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6-8, 10, 11, 13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

Applicant's Amendment filed on *09 October 2008* is acknowledged.

All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants". Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

This paper is given Paper No. 20090105 by the Examiner. This Paper No. is for reference purposes only.

### ***Status of Claims***

Claims *1, 3, 6-8, 10, 11, 13, 16 and 17* have been examined and pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**Claims 1, 3, 6-8, 10, 11, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0133793 A1 (Ginter et al.; hereinafter “Ginter”), in view of 5,548,574 (Shimoyoshi et al.; hereinafter “Shimoyoshi”), further in view of US 6,499,106 B1 (Yaegashi et al.; hereinafter “Yaegashi”), and further in view of US 5,893,910 (Martineau et al; hereinafter “Martineau”).**

As per the following claims, Ginter discloses:

1. Ginter discloses a digital signal processing apparatus comprising:

- transmitting means for transmitting inquiry information to an information center over a communication line, said inquiry information being generated in association with encoded digital data which have been recorded on a storage medium [0008; 0221-0222];
- receiving means for receiving a result of an inquiry conducted by said information center based on said inquiry information [0226-0240];
- discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium are legally purchased data [1118, 1126, 1540, 1858, 1971-1975]; and
- controlling means which, when said discriminating means judges said encoded digital data to be legally purchased data, then executes a process to offer an additional service to said customer, wherein said additional service offered to said customer [0057-0093, 0192, 0208, 0215-0222].

Ginter does not explicitly disclose that the controlling means also includes moving said encoded data from said storage medium to another storage medium;

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restoring said encoded digital data onto said storage medium if the encoded digital data has been partially destroyed; and converting and replacing said encoded digital data recorded on said storage medium into encoded digital data of a different bit rate.

Shimoyoshi, however, teaches controlling means that includes moving said encoded data from said storage medium to another storage medium; restoring said encoded digital data onto said storage medium; and converting and replacing said encoded digital data recorded on said storage medium into encoded digital data of a different bit rate (see **Summary columns 3-4; col 8, 36-col 10, 24; col. 21-22**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ginter to include the mechanism of Shimoyoshi to provide a recording/reproducing apparatus which is capable of accommodating plural usages having different demand levels while reducing the economic load without jeopardizing and lowering the dependability and quality to the customer, respectively.

Neither Ginter nor Shimoyoshi, taken alone or in combination thereof teach or suggest such a digital signal processing apparatus, the apparatus further comprising:

- *said transmitted inquiry information including a particular frame of music data extracted from encoded digital data that have been recorded on a storage medium;*
- *the result of the transmitted inquiry indicating whether the extracted particular frame of music data matches a corresponding frame of music data stored in the information center, the stored frame of music data being encoded or recorded in a manner consistent with the digital signal processing apparatus, the extracted*

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*particular frame of music data matching the stored frame of music data only when the encoded digital data recorded on the storage medium was encoded or recorded in the manner consistent with the digital signal processing apparatus;*

- discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium was **encoded or recorded in the manner consistent with the digital signal processing apparatus** and thus legally purchased data;
- controlling means for *executing*, in response to said discriminating means judging said encoded digital data to be legally purchased data, **a process to offer an additional service to said customer.**

**Yaegashi**, however, teach a method and apparatus for securing distribution of information recorded on fixed media (i.e., claimed storage medium), the method further comprising:

- *said transmitted inquiry information including a particular frame of music data extracted from encoded digital data that have been recorded on a storage medium* (see at least the **Abstract, col. 8 ll. 60 – col. 11 ll. 21**);
- *the result of the transmitted inquiry indicating whether the extracted particular frame of music data matches a corresponding frame of music data stored in the information center, the stored frame of music data being encoded or recorded in a manner consistent with the digital signal processing apparatus, the extracted particular frame of music data matching the stored frame of music data only when the encoded digital data recorded on the storage medium was encoded or*

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*recorded in the manner consistent with the digital signal processing apparatus*

(see at least the **Abstract, col. 8 ll. 60 – col. 11 ll. 21**);

- discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium was ***encoded or recorded in the manner consistent with the digital signal processing apparatus and thus legally purchased data*** (see at least the **Abstract, col. 8 ll. 60 – col. 11 ll. 21**),

to determine whether or not the encoded digital data recorded on the storage medium is legitimate, i.e., legally purchase.

**Martineau**, however, teach a method and apparatus for establishing or determining the legitimacy of use of a block of digitally represented information recorded on fixed media (i.e., claimed storage medium), the method further comprising:

- controlling means for *executing*, in response to said discriminating means judging said encoded digital data to be legally purchased data, ***a process to offer an additional service to said customer*** (see at least **col. 9 ll. 14-16**),

to offer an additional service to the customer whose encoded digital data recorded on a storage medium is determined to be legitimate, i.e., legally purchased.

Therefore, it would have been obvious to and motivated by an ordinary skill in the art at the time the invention was made to modify a digital signal processing apparatus as taught in the combination of the Ginter and Shimoyoshi references to add the following features:

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- *said transmitted inquiry information including a particular frame of music data extracted from encoded digital data that have been recorded on a storage medium;*
- *the result of the transmitted inquiry indicating whether the extracted particular frame of music data matches a corresponding frame of music data stored in the information center, the stored frame of music data being encoded or recorded in a manner consistent with the digital signal processing apparatus, the extracted particular frame of music data matching the stored frame of music data only when the encoded digital data recorded on the storage medium was encoded or recorded in the manner consistent with the digital signal processing apparatus;*
- discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium was **encoded or recorded in the manner consistent with the digital signal processing apparatus** and thus legally purchased data;
- controlling means for *executing*, in response to said discriminating means judging said encoded digital data to be legally purchased data, **a process to offer an additional service to said customer**,

to determine the legitimacy of an encoded digital data recorded on a storage medium, and based upon this determination, offer an additional service to the customer whose encoded digital data recorded on such a storage medium is determined to be legitimate, i.e., legally purchased.



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2. Canceled.

3. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded on said storage medium with an algorithm of a predetermined version, into digital data having undergone encoding with an algorithm of a more advanced version, before replacing the unconverted digital data with the converted digital data on said storage medium (**Ginter, [0965, 1478, 1511, 2017, 2280]**).

4. Canceled.

5. Canceled.

6. Ginter further discloses a digital signal processing apparatus according to claim 1, wherein said additional service offered to said customer comprises furnishing said customer, free of charge, with a product related to a producing party who produced said digital data purchased legally by said customer from said information center [**0107-0141**].

7. Ginter further discloses a digital signal processing apparatus according to claim 1, further comprising inputting means for inputting identification information for identifying said encoded digital data which are subject to said inquiry; wherein said identification information input through said inputting means is transmitted to said information center

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over said communication line **[0193-0229]**.

8. Ginter further discloses a digital signal processing apparatus according to claim 7, wherein said information center comprises: receiving means for receiving said inquiry information and said identification information transmitted from said digital signal processing apparatus; retrieving means for retrieving digital data subject to said inquiry from said received inquiry information, the retrieved digital data subject to the inquiry including the extracted particular frame of music data; reference inquiry information generating means for generating reference inquiry information corresponding to said retrieved digital data subject to the inquiry, the generated reference inquiry information including the stored frame of music data; comparing means for comparing the generated reference inquiry information and the retrieved digital data subject to the inquiry; inquiry result generating means for generating the result of the inquiry based on a result of the comparison by said comparing means; and transmitting means for transmitting the result of the inquiry to said digital processing apparatus **[0509, 0722]**.

9. Canceled.

10. Ginter further discloses a digital signal processing apparatus according to claim 1, further comprising charging means for processing charges; wherein, **if** said discriminating means judges that said encoded digital data recorded on said storage medium are legally purchased data, then said charging means either charges nothing or

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a reduced amount to said customer for said additional service offered to said customer [0222-0272].

Claims 11, 13, 16 and 17 are directed to a method of the above-recited apparatus and are similarly rejected.

12, 14, 15 and 18-28. Canceled.

### ***Response to Arguments***

Applicant's arguments with respect to above-noted claims have been fully considered but they are not persuasive.

Please note that the amendments fail to further limit the claims because **optional** or **conditional elements** *do not narrow the claims because they can always be omitted*. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

"As a matter of linguistic precision, **optional elements** *do not narrow the claim because they can always be omitted.*" *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board's claim

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construction of "further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased" since "this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form 'may.'").

Applicant contends "none of the relied on sections of Ginter, of Shimoyoshi, of Yaegashi, of Martineau teach or suggest inquiry information including a particular frame of music data ... nor concern with a particular frame of music data " (Remarks, pgs. 8-12). The Office respectfully disagrees because the claimed particular frame of music data is still electronic or digital data or information and is indeed taught in the Yaegashi reference in at least the Abstract, col. 8 ll. 60 – col. 11 ll. 21. Furthermore, the claimed particular frame of music data qualifies to be a **non-functional descriptive material** because it is just electronic or digital data or information that does not change or differ from the method taught in the prior art (Yaegashi), thus, it cannot be obvious or patentable over the prior art.

### **Conclusion**

Examiner has cited particular columns and line numbers and/or paragraph and/or page numbers in the prior arts of record as applied to the claims above in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to fully consider the references

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in its **entirety** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is (571) 272-7066. The examiner can normally be reached on Monday - Friday, 9am - 6:00pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on (571) 272-6779.

For **official/regular communication**, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

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For **informal/draft communication**, the fax number is **(571) 273-7066**  
**(Rightfax).**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NANCY T. LE  
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/  
Primary Examiner, Art Unit 3621